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Patent and Trademark Office**

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*SR*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/116,425    07/15/98    PIECHOWIAK

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024251    QM32/0914  
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EXAMINER

CHERUBIN, Y

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

09/14/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/116,425

Applicant(s)

PIECHOWIAK ET AL.

Examiner

Yveste G. Cherubin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to the Amendment filed on September 4, 2001 in which claims 1-16 are pending.

#### Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-6, 8-9, 13-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Manship et al. (US Patent No. 5,393,061).

As per claims 1-2, 4-5, Manship discloses a video gaming system including a display screen on which the spinning wheels of a slot machine are simulated. Each simulated wheel is divided into a number of cells with each cell having a game element such as a "cherry", an "orange", a "bar", etc. Stored in the machine are payout tables which assign payout value to predetermined combinations of game elements considered to be winning combinations of game elements that may appear on the screen during a game play. In fig 2, the display screen shows the credit total (40) accumulated by the player and the total number of credits bet (41) for each game play. The display screen also shows a bonus credit total (42) accumulated during game play together with an indicator area (44). Manship's system runs two modes of play which are a regular mode and a special (bonus) mode called "fever mode", 5:28-41. When reached a certain predetermined criteria or advanced into the special or bonus or fever mode, the display

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colors in the indicator area (44) are enhanced and the elements of "bells" are displayed in one or more of the cells in the array. During that bonus or fever mode the bells are enlarged and swing back and forth on the screen, and the audio output of the machine changes and rings in time with the swinging motion of the bells, 7:10-63. It should be apparent that although using an enhanced feature for the bonus or fever mode that Manship's device is using the same display to display both games, the primary or regular mode and the bonus and fever mode. Upon winning, players are awarded coins or allowed to select the form in which accumulated credits are to be redeemed, 10:53-60. As per claim 3, 6, Manship discloses that the bonus credit total is added to the credit total, 6:51-60. As per claims 8, 13, Manship in Fig 2, discloses using video reels. Regarding claims 9, 14, Manship in Fig 1, displays grid patterns (32).

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manship (US Patent No.5,393,061) in view of Marnell, II (US Patent No.5,393,057).

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As per claims 7-16, Manship discloses the claimed invention as substantially as shown above. However, Manship does not disclose using the different types of indicia such as playing cards, letters and numbers in his system. Marnell, II, in Figs. 1 and 2, displays different types of indicia such as playing cards and letters. It would have been obvious to one of ordinary skill in the art to provide the indicia of Marnell into the Manship type system in order to provide various types of games and therefore attract various types of players.

### ***Response to Arguments***

Applicant's arguments filed on September 4, 2001 have been fully considered but they are not persuasive. Applicant argues that Manship does not anticipate Applicant's invention of claim 1. Examiner's submits that Applicant's interpretation of the reference is inaccurate. The Manship reference is directed to a system that runs two modes of play, which are a *first* or regular *mode* and a *second* or special or bonus *mode* called "fever mode". Examiner's interpretation of the Manship reference is that on the regular or *first mode*, Manship uses randomly selected *first indicia* to display the game result of the *first* and regular *mode* and when the game result of the first or regular mode meets certain criteria a *second* or special or bonus *mode* called "fever mode" uses randomly selected *second indicia* to display the game result of the *second mode*. Examiner believes that the Manship reference explicitly discloses Applicant's claimed limitation in claims 1 and 4 which state "generating a *first* game result, by displaying a combination randomly selected from *first indicia*..... and generating a bonus game result, by displaying *second indicia*.....". Claim 1 does not state that the first indicia displayed on

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the first or the regular game are different from the second indicia of the second or bonus game. Examiner believes that Applicant is reading claims 7, 8, 10, 11 into claims 1 and 4, therefore Applicant is arguing limitations that are not in claims 1 and 4. Examiner needs to remind Applicant that claims 1-16 cannot be examined as a whole but each claim needs to be examined separately. Further, on page 2, 2<sup>nd</sup> paragraph, Applicant argues that Manship's bell in the second or bonus game is the same bell "indicia" used in the first or regular game. Examiner disagrees and believes that the bells used in the first game are different from the bells used in the second or bonus game, since they are different in appearance shown by size, sound, colors and action (swing back and forth). Broadly interpreted, they are definitely not the same bells (indicia). As for having indicia represented by playing cards, symbols on a video reel, letters and numbers, these are well known features provided in video game system, but, in addition, Examiner cited Marnell to provide a system wherein first indicia are generated in a primary game and second indicia, different from the first indicia, are generated in a secondary game. It would have been obvious to one of ordinary skill in the art to provide the indicia of Marnell into the Manship type system in order to provide various types of games and therefore attract various types of players. The Manship reference was further cited to teach one display capable of displaying both game modes. Thus, Examiner believes that the Manship and Marnell references both meet all the claimed limitations as stated in the previous action, therefore the rejection stands.

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***ACTION FINAL***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the **statutory** period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

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September 12, 2001

ygc

A handwritten signature in black ink, appearing to be 'ygc' with a stylized flourish.A handwritten signature in black ink, appearing to be 'J. Harrison' with a long horizontal line extending to the right.

JESSICA J. HARRISON  
PRIMARY EXAMINER

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.